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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,490	09/12/2000	Tadahiro Aihara	04329.2392	6306
22852	7590	05/03/2005	EXAMINER	
FINNNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			FLANDERS, ANDREW C	
			ART UNIT	PAPER NUMBER
			2644	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/660,490	AIHARA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andrew C Flanders	2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 21 March 2005.

2a) This action is **FINAL**.                                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-34 is/are rejected. *no*

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 12 September 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. **Claim 11** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **Claim 11**, the term "means for keeping reproduction of said reproducing means" is unclear to the examiner. For the purpose of expediting prosecution, the term will be understood as maintaining the data to be played back in a buffer.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1 – 4, 17 – 20 and 33 - 34** are rejected under 35 U.S.C. 102(b) as being anticipated by Murray (U.S. 5,699,089).

Regarding **Claims 1 and 17**, Murray discloses a recording process that begins when a process record button is pressed (Fig. 6G element 6056), determining whether the device is currently playing (Fig. 6G element 6148), if so stopping that playback (Fig. 6G element 6058) and then recording if a telephone connection is established (Fig. 6G element 6150) (i.e. means for recording a content supplied from an external device,

means for reproducing the content, means for determining whether or not said reproducing means performs a reproduction when a recording command is issued; and means for disabling said reproducing means and enabling said recording means when said determining means determines that said reproducing means performs the reproduction when the recording command is issued).

Regarding **Claims 2 and 18**, in addition to the elements stated above regarding claims 1 and 17, Murray further discloses if the system is not currently playing to advance to the recording step (Fig. 6G element 6148 and 6150) (i.e. means for enabling said recording means when said determining means determines that said reproducing means does not perform reproduction).

Regarding **Claim 3 and 19**, in addition to the elements stated above regarding claims 1 and 17, Murray further discloses determining whether the system is currently recording when the record button is pressed (Fig. 6G element 6140), (i.e. second determining means for determining whether or not said recording means is turned on when the recording command is issued) and if not, the system eventually advances to step 6150 where the system begins recording (Fig. 6G) (i.e. means for turning on said recording means when said second determining means determines that recording means is not turned on).

Regarding **Claim 4 and 20**, in addition to the elements stated above regarding claims 1 and 17, Murray further discloses when the record button is pressed they system completes the request and then waits for the next event (Fig. 6B elements 6042, 6056 and 6030) and a play button for playing back data as the next event (Fig. 6B

element 6040) (i.e. means for restarting interrupted reproduction after recording is completed).

Regarding **Claim 33**, Murray discloses recording (Fig 6G) (i.e. means for recording a content supplied from an external device), playing (Fig. 6G) (i.e. means for reproducing the content), determining if a telephone connection is established (Fig. 6G) (i.e. means for determining whether or not the apparatus is connected to the external device); and stopping playback if a recording command is issued and recording if the telephone connection is established (Fig. 6G elements 6148, 6127, and 6150) (i.e. means for disabling the reproducing means to stop reproduction of the content and enabling the recording means to start recording of a new content when said determining means determines that the apparatus is connected to the external device)

Regarding **Claim 34**, in addition to the elements stated above regarding claim 33, Murray further discloses when the record button is pressed the system completes the request and then waits for the next event (Fig. 6B elements 6042, 6056 and 6030) and a play button for playing back data as the next event (Fig. 6B element 6040) (i.e. means for enabling the reproducing mode to restart reproduction after the recording of the new content is completed).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 5 – 8 and 21 – 24** are rejected under 35 U.S.C. 102(e) as being anticipated by Moon (U.S. Patent 6,629,000)

Regarding **Claims 5 and 21**, Moon discloses a transmitter/receiver that receives data from a PC (Fig. 2 element 800) (i.e. means for recording a content supplied from an external device), headphones and speakers (Fig. 2 element 705) (i.e. means for reproducing the content), determining if there is a connection with the external device (Fig. 3a element 1800) (i.e. means for determining whether or not the apparatus is connected to the external device), an information selector portion (fig. 2 element 300) (i.e. means for selectively setting an operation mode) and the information selector contains predetermined keys operated by the user, and outputs electrical signals according to the user selections to control the supply of power, extract data for reproduction, control various functions related to the reproducing of data and transmit and receive data (col. 3 lines 59 – 65) (i.e. means for controlling said recording means and said reproducing means in accordance with the operation mode set by said setting means when said determine means determines that the apparatus is connected to the external device).

Regarding **Claims 6 and 22**, in addition to the elements stated above regarding claims 5 and 21, Moon discloses connecting to an external device and not communicating with that device until sound data is not being reproduced (Fig. 3a elements 1700 and 1800, Fig 3b element 1420, Fig 3e, and Fig 3f) (i.e. wherein said setting means sets one of a first mode, a second mode, a third mode, and a fourth

mode; and the first mode is set, reproduction is continued if the apparatus is connected to the external apparatus during reproduction).

Regarding **Claims 7 and 23**, in addition to the elements stated above regarding claims 5 and 21, Moon discloses a reproduction signal (Fig. 3b element 1420) (i.e. wherein said setting means comprises an interface device for manually setting the operation mode).

Regarding **Claims 8 and 24**, in addition to the elements stated above regarding claims 5 and 21, Moon discloses determining whether the device is connected to an external system (Fig. 3a element 1800). In order to determine whether the system is connected it is inherent there must be some sort of communication from the external system to the device whether it be a signal or an impedance detection it is supplied by the external system (i.e. wherein said setting means comprises means for receiving a mode setting command from the external device).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 9 – 16 and 25 - 32** rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows (U.S. Patent 6,377,530).

Regarding **Claims 9 and 25**, Burrows discloses a computer jack (Fig. 1 element 132) (i.e. means for recording a content supplied from an external device), a compressed audio data buffer and an audio output jack (Fig. 1 elements 108 and 130) (i.e. means for reproducing the content the reproducing means buffering content data before reproduction), and storing a predefined amount of audio data in a buffer when the audio player is commanded to stop (col. 2 lines 60 – 68) (i.e. means for detecting that a sufficient amount of the content data is buffered when a command is issued during reproduction). Burrows does not explicitly disclose the command as a recording command or means for enabling said recording means when said detecting means detects that the sufficient amount of the content data is buffered. However, it would have been obvious to one of ordinary skill in the art to stop the audio player when it is connected to the computer system via computer jack 132 in figure 1. One would have been motivated to do so to minimize the amount of processing used during the transfer. It would be desirable to minimize the processing in order to save battery power. Burrows teaches that portable audio players typically rely on batteries to provide power and it is desirable for the audio player to consume as little power as possible (col. 1 lines 10 – 23).

Regarding **Claims 10 and 26**, in addition to the elements stated above regarding claims 9 25, Burrows discloses storing a predefined amount of audio data in a buffer when the audio player is commanded to shut down (col. 2 lines 60 – 68) to play when the portable audio player is commanded to resume playing (col. 3 lines 1 – 5). It is obvious that the audio player would not shut down until the required amount of data was

buffered in the memory, see col. 7 lines 20 – 40 (i.e. disabling said recording means when said detecting means does not detect that the sufficient amount of the content data is not buffered).

Regarding **Claim 11 and 27**, in addition to the elements stated above regarding claims 10 and 26, Burrows discloses storing a predefined amount of audio data in a buffer when the audio player is commanded to shut down (col. 2 lines 60 – 68) (i.e. further comprising means for keeping reproduction of said reproducing means when said detecting means detects that the sufficient amount of the content data is buffered).

Regarding **Claims 12 and 28**, in addition to the elements stated above regarding claims 10 and 26, Burrows discloses storing a predefined amount of audio data in a buffer when the audio player is commanded to shut down (col. 2 lines 60 – 68) It is obvious that the audio player would not shut down until the required amount of data was buffered in the memory, see col. 7 lines 20 – 40 (i.e. further comprising means for starting said recording means when said detecting means detects that the sufficient amount of content data is buffered).

Regarding **Claims 13 and 29**, in addition to the elements stated above regarding claims 9 and 25, Burrows discloses a user interface with various settings (fig. 1 element 116) (i.e. means for setting an operation mode) and storing a predefined amount of audio data in a buffer when the audio player is commanded to stop (col. 2 lines 60 – 68). Again as stated above regarding claim 9 it would have been obvious to one of ordinary skill in the art to stop the audio player when it is connected to the computer system via computer jack 132 in figure 1. (i.e. means for controlling said recording

means and said reproducing means in accordance with the operation mode when said detecting means detects that the sufficient amount of the content data is not buffered).

Regarding **Claims 14 and 30**, in addition to the elements stated above regarding claims 13 and 29, Burrows discloses storing a predefined amount of audio data in a buffer when the audio player is commanded to stop (col. 2 lines 60 – 68). Again as stated above regarding claim 9 it would have been obvious to one of ordinary skill in the art to stop the audio player when it is connected to the computer system via computer jack 132 in figure 1 (i.e. wherein said setting means sets one of a first mode, second mode, third mode and forth mode, wherein in the second mode reproduction is stopped and recording is started if the apparatus is connected to the external apparatus during reproduction).

Regarding **Claims 15 and 31**, in addition to the elements stated above regarding claims 14 and 29, Burrows discloses a user interface with various settings (fig. 1 element 116) (i.e. wherein said setting means comprises an interface device for manually presetting the operation mode).

Regarding **Claims 16 and 32**, in addition to the elements stated above regarding claims 13 and 29 Burrows further discloses a computer jack for connecting to an external device. In order to determine whether the system is connected it is obvious there must be some sort of communication from the external system to the device whether it be a signal or an impedance detection it is supplied by the external system (i.e. wherein said setting means comprises means for receiving a mode setting command from the external device).

***Allowable Subject Matter***

The indicated allowability of claims 9 – 16 and 25 - 32 is withdrawn in view of further review of the Burrows reference. Rejections based on the newly cited reference(s) are above.

***Response to Arguments***

Applicant's arguments filed 21 March 2005 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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ADVISORY PATENT EXAMINER